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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant	:	Jackwerth et al.
Appl. No.	:	09/831,431
Filed	:	07/13/01
Title	:	UTILIZATION OF CATION-ACTIVE MIXTURES
Grp./A.U.	:	1617
Examiner	:	G. Yu
Docket No.	:	H 3739 PCT/US

10/15/02

CERTIFICATE OF MAILING

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October 10, 2001
Date

Marlene Capreri
Signature of certifier

Marlene Capreri
Typed or printed name of certifier

Commissioner for Patents
Washington, DC 20231

TRANSMITTAL OF REPLY BRIEF

Sir:

On September 10, 2002, an Examiner's Answer to Appellants' brief in support of the appeal against the final rejection of the pending claims in the above captioned application was mailed. What follows in the remainder of this paper is Appellant's reply brief, as permitted under 37 C.F.R. § 1.193(b).

Appellant respectfully requests the Board of Patent Appeals and Interferences, before making its decision on this appeal, to consider the following rebuttals to statements made in the Examiner's Answer, as set forth specifically below.

Statement: *"As shown by the recited teachings, the instant claims define nothing more than the concomitant use of four conventional skin care or hair care ingredients old and well known for the use, and it would follow that the recited claims define prima facie obvious subject matter." (Part (11), page 4 of the Answer).*

Rebuttal: The Examiner appears to be operating under the mistaken belief that merely because the elements used to define a claim are old and well known, the subsequent combination is per se obvious. Unfortunately, the Examiner has failed to cite any legal precedent in support of this apparent belief. However, in rebuttal thereto, Appellant would like to note that it has been settled that the simple assertion that each of the various elements recited in the claims is old and known **does not** establish a prima facie case of obviousness, for as Chief Judge Markey noted in *Panduit Corp. v. Dennison Mfg. Co.,* 1 USPQ 1593, 1603 (Fed. Cir. 1987), virtually all inventions are combinations of old elements so that the use of old elements does not alone make an improvement unpatentable.

Statement: *"...what applicants alleges is a "teaching away" in this case is not directed to specific combinability of the components of the instant claims as in In re Braat. Instead, applicants assert that Inman teaches away from using conventional conditioning oil in shampoo in general, citing the Inman's description of the undesirable feel of such compositions. Applicants' assertion is in error since Inman teaches at column 1, line 55 that oils can provide hair conditioning benefits, albeit with a caveat. (Part (11), page 5 of the Answer)*

Rebuttal: Contrary to the Examiner's assertion, Appellant's alleged "teaching away" by the Inman reference from the claimed invention is precisely based on the combinability

of the claimed components. More particularly, Appellant's position has been, and continues to be, that the Inman reference "teaches away" from the **combination** of the **claimed** oil component with the remaining **claimed** components. The Inman reference states in col. 1, lines 53-58, "Although these conditioning oils can provide some wet hair conditioning benefits, the wet conditioned hair is often characterized as slimy or excessively conditioned..." The "caveat" referred to by the Examiner is precisely what forms the basis for Appellant's allegation that this reference "teaches away" from the claimed invention. Namely, the Inman reference clearly teaches that only **select** combinations of certain organic conditioning oils and cationic conditioning polymers, provides improved conditioning performance. See, col. 1, lines 59-62 of the Inman reference. Clearly, therefore, unless this **select** combination of components is employed, the use of a conditioning oil will do more harm than good by imparting a "slimy feeling" onto the hair. A clearer case of "teaching away" from the claimed invention would be hard to fashion.

Statement: *"Applicants also assert the Inman teaching would motivate a skilled artisan use oil components only with the combination of the cationic polymers and a synthetic ester. In response, examiner reiterates that the scope of the instant claims does not exclude using cationic polymers in the composition." (Part (11), page 6 of the Answer)*

Rebuttal: While it is true that the claimed invention does not exclude the use of cationic polymers, the question is whether one of ordinary skill in the art would still be motivated to use an oil component, **in the absence of a cationic polymer**, as is taught by the Inman reference. Appellant respectfully submits that based on the clear teaching of the Inman reference one of ordinary skill in the art, after having read this reference, would **NOT** be motivated to employ said oil component in the absence of said cationic polymer. In support of this position, Appellant would like to note that it is has been held

that, "A person of ordinary skill in the art would reasonably expect that, if what is taught as an essential ingredient is not included, an undesirable reaction or no reaction at all would occur." See, *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir. 1983). It is therefore Appellant's contention that one of ordinary skill in the art would conclude that if a cationic polymer were not used, as is the case in the present invention even though its use is not expressly prohibited, the resultant use of a conditioning oil will cause the hair to feel "slimy", per the teaching of Inman.

In view of the arguments given above, and in the Appeal Brief, reversal of all the rejections is respectfully requested.

Respectfully submitted,

Steven J. Trzaska
(Reg. No. 36,296)
Attorney for Applicant(s)
(610) 278-4929

Cognis Corporation
2500 Renaissance Blvd., St. 200
Gulph Mills, PA 19406

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